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EXAMINER

CAI, WAYNE HUU

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM E. MAZZARA and MIKE A. HICHME

Appeal 2007-3287
Application 10/040,049
Technology Center 2600

Decided: March 11, 2008

Before: ANITA PELLMAN GROSS, ROBERT E. NAPPI, and
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from final rejections of claims 25-46. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants disclose methods for providing communication for a mobile vehicle over multiple paths. (Spec. 1: 8-10). The application details that the availabilities and capabilities of an embedded device and a portable network access device are determined, and a connection to a network is made based on that determination. (Spec. 3: 2-12).

Independent claim 25, which is deemed to be representative, reads as follows:

25. A method for connecting to a network, the method comprising:
- receiving a network connection request at a system master;
 - determining availability of at least one embedded device, the embedded device embedded in a vehicle, and at least one portable network access device, based on the network connection request;
 - determining capability of the at least one embedded device and at least one portable network access device based on the determined availability; and
 - initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Yamashita	US 2001/0011033 A1	Aug. 2, 2001
Holmström	US 6,741,870 B1	May 25, 2004
Khullar	US 6,748,246 B1	Jun. 8, 2004

The Examiner rejected claims 25, 34, 37, and 46 under 35 U.S.C. § 102(e) as anticipated by Yamashita. The Examiner also rejected claims 26, 33, 35, 38, and 45 under 35 U.S.C. § 103(a) as unpatentable over Yamashita. The Examiner rejected claims 27-32 and 39-44 under 35 U.S.C. § 103(a) as unpatentable over Yamashita and Khullar. The Examiner also rejected claim 36 under 35 U.S.C. § 103(a) as unpatentable over Yamashita

and Holmström. We further note that claims 25, 37, and 46 were rejected in the final Office Action under 35 U.S.C. § 112, second paragraph, as being indefinite, but that rejection was withdrawn by the Examiner (Ans. 8) and is thus not reviewed in this decision.

Appellants contend that the Examiner erred in indicating that the claimed subject matter would have been anticipated or obvious. More specifically, Appellants argue that Yamashita does not disclose initiating a connection based on a capacity determination. (Br. 12-13). Appellants also argue that the rejection applying Yamashita and Khullar lacked sufficient motivation to combine the references. (Br. 13-14). The Examiner finds that Yamashita teaches all of the elements of the anticipated claims and that the obviousness-type rejection is proper. (Answer 8-11).

We affirm.

ISSUE

Have Appellants shown that the Examiner erred in finding claims 25, 34, 37, and 46 anticipated or claims 26-33, 35, 36 and 38-45 obvious in view of the cited prior art references?

FINDINGS OF FACT

1. The application details communication occurring between a vehicle and a service provider through communication networks or wide area networks, and one or more service providers. A portable communications device (PCD) is linked to an embedded device of a vehicle capable of communicating with a service provider. The availability of the embedded

device and the availability of the portable network access device are determined, and a connection is made using one of those devices based on capacity determinations. (Spec. 4: 20-24; 6: 17-22; 9: 2-11; 7; Figs. 1-3, elements 100, 110, 130, 135, 205, 230, 245).

2. Independent claims 25, 37, and 46 all recite, in part, “determining capability of the at least one embedded device and at least one portable network access device.” The limitation “capability” is not defined in the Specification or the claims, although the Specification describes determining battery life and a battery life threshold. Dependent claims 27 and 39 recite that the capacity determination can be based on “battery life viability, relative signal strength indication, service availability, type of service and call state.” (Spec. 10: 2-17).

3. Yamashita discloses an apparatus for mobile communications usable with a plurality of communications systems. First and second radio communication sections are supplied to the signal processing unit, which communicate with the CPU. When call initiation is requested, the CPU checks the standby state of the radio communication sections. If only the second radio communication section is standing by, call initiation will be processed by the second radio communication section. If both radio communication sections are standing by, the CPU will check the presence or absence of a detection signal. If a detection signal is detected, call initiation processing is done by the second radio communication section. (Paragraphs [0002]; [0034]; [0051]-[0052]; Figs. 1 and 3, elements 1-3, S201 and S203).

4. Yamashita details that cordless systems are relatively cheap but do not warrant communication capability when in high speed traffic.

Yamashita also discloses that a system may be automatically selected as being suitable for a given environment of use, because a communication system which warrants communication during high speed transit and another system which does not, are selectively used by judging the possibility of fast transit. (Paragraphs [0004] and [0063]).

5. Khullar discloses processes for selecting an access technology in a multi-mode terminal. The selection may look to a low power mode, a low battery indication, the type of information exchanged, minimum radiated power levels, and geographic position data. (Abstract; Col. 4, ll. 1-43).

6. Holmström discloses a system whereby one or more communication devices can automatically switch between physical communication interfaces on an as needed basis. If the communication is interrupted inadvertently, either device can attempt to reinitiate the communication in accordance with a priority list. (Abstract; Col. 3, ll. 1-12).

PRINCIPLES OF LAW

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining &*

Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565 (Fed. Cir. 1992).

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the prima facie case with argument and/or evidence. *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997). “Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007).

“Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41.

The claims on appeal should not be confined to specific embodiments described in the Specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*). During *ex parte* prosecution, claims must be interpreted as broadly as their terms reasonably allow since applicants have the power during the administrative process to amend the claims to avoid the prior art. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

ANALYSIS

Appellants argue that Yamashita fails to disclose initiating a connection based on the capability determination and that Yamashita, at most, teaches that the connection is made based on the speed of the vehicle. Appellants acknowledge that Yamashita provides for “mobile communications capable of automatically accessing the most suitable system for intended communication.” (Br. 12). The Examiner responds that the connection is made based on the ability or capability to communicate, which is a capability determination. (Answer 9). We agree with the Examiner.

The limitation “capability” has not been redefined in the Specification, (Findings of Fact 2), and the limitation should be construed according to its normal meaning. The dependent claims also make clear that the capability determination can be based on several factors, (Findings of Fact 2), and the capacity or capability to communicate in the given circumstances would fall within a general capability determination. While Appellants argue that the determination in Yamashita is based only on “suitability or appropriateness,” (Reply Br. 4), Yamashita makes clear that the suitability or unsuitability is related to the communication capability of that mode of communication. (Findings of Fact 4). As such, we find Yamashita teaches the disputed limitations in claims 25, 37, and 46 and find no error in the anticipation rejection of those independent claims. Dependent claim 34 was also rejected as being anticipated by Yamashita, was not separately argued by Appellants, and we affirm the rejection of that claim as well.

With respect to the rejection of claims 27-32 and 39-44 over Yamashita and Khullar, Appellants argue that there is no motivation to combine those references. Appellants argue that the cited motivation, “to determine the ability to make a connection or service, and make the communication more reliable and efficient,” does not come from either reference and the mere fact that the references can be modified does not render the combination obvious. (Br. 13-14). Appellants are reminded that motivation to combine references in an obviousness rejection need not come directly from the references themselves, but may come from various sources. We find the motivation to combine the references proffered by the Examiner in the rejection to be sufficient, given the disclosures of those references, and we find no error in the rejection of claims 27-32 and 39-44.

Appellants also argue that the rejections of claims 26, 33, 35, 36, 38, and 45 are improper based on the arguments raised against the independent claims. Because we affirm the rejections of the independent claims, we also affirm the rejections of the above-listed dependent claims.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 25-46, and we affirm the Examiner’s rejections of those claims under 35 U.S.C. §§ 102(e) & 103(a).

DECISION

The decision of the Examiner is affirmed.

Appeal 2007-3287
Application 10/040,049

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

tdl/gw

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